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EXAMINER

LEVINE, ADAM L

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/731,939

Applicant(s)

GABOS ET AL.

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12 March 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on March 12, 2004, was filed after the mailing date of the application on December 9, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- Fig. 2A does not have any reference signs. If Fig. 2A is a summary of Figs. 2B-2D, the appropriate reference numbers of Figs. 2B-2D should be included in Fig. 2A as appropriate;

- Fig. 8 does not have a reference number 335;
- Fig. 10 does not have a reference sign for the recipe items.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- Fig. 2B reference characters 158, 162, and 172;
- Fig. 2C reference characters 190 and 194;
- Fig. 2D reference characters 208 and 212;

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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4. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are objected to by the Draftsperson. Please see the attached Notice of Draftpersons Patent Drawing Review. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

#### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

### ***Specification***

5. The disclosure is objected to because of the following informalities: Drawing Figs. 8 and 10 do not match their descriptions.

Appropriate correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

7. Claim 15 is objected to because of the following informalities: The lettering of the subparagraphs includes two "(c)'s". The second "(c)" should be a "(d)". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**8. Claims 1-8, 11-13, 15-22, and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruppert (US Patent No. 5,424,524).**

Ruppert teaches all of the limitations of claims 1-28. For example, Ruppert discloses a system and method for managing a shopping event at one or more retail locations. Ruppert further discloses:

**Regarding Claims 1 and 15**, a computing system and a method for managing a shopping event at one or more retail locations, comprising:

- a hand-held computer to receive shopping list information from a user, and the generation of a shopping list on the hand-held computer (see at least in the abstract, at column 1 lines 60-66, and at column 4 lines 40-55); the shopping list information defining a collection of products to be purchased during the shopping event;
- a computing system operable with the hand-held computer; the system configured to receive the list and distribute one or more information packets associated with each of the products to the hand-held computer in advance of the shopping event, and the method providing the list the system and receiving one or more information packets associated with each of the products from the system in advance of the shopping event (see at least column 2 lines 43-54 and column 6 lines 27-38); and
- a computing system associated with each of the retail locations communicating with the hand-held computer; the system configured to receive

shopping list information and information packets associated with each of the products from the hand-held computer as the user completes the shopping event, and the method distributing the shopping list and the information packets to a computing system associated with the one or more retail locations (see at least the abstract, and as described above, where information is transferred in both directions between the retail location computer and the hand-held computer in order for the hand-held to receive relevant product information in return, and at least column 9 lines 51-61, and column 12 lines 10-18).

**Regarding Claims 2 and 16**, the system and method of claims 1 and 15, wherein the shopping list information and information packets associated with each of the products is communicated between the hand-held computer and the system electronically in both directions (see at least the abstract and column 1 lines 48-66. Please note examiner's interpretation: downloading information by modem, scanning information into the system, and the bidirectional communication port/device described are electronic).

**Regarding Claims 3 and 17**, the computing system and method of claims 1 and 15, wherein the information packets distributed and received from the server computing system includes one or more promotional offers redeemable at one of the retail locations (see at least column 1 lines 48-66).

**Regarding Claims 4 and 18**, the computing system and method of claims 3 and 17, wherein the one or more promotional offers include a unique identifier, and the system and method measure the effectiveness of the promotional offer by verifying



whether the promotional offer has been redeemed by the user (see at least column 2 lines 43-54).

**Regarding Claims 5 and 19**, the computing system and method of claims 1 and 15 wherein the system and method provide an alert to the user as the user completes the shopping event (see at least column 9 lines 50-61 and column 10 line 61 to column 11 line 5).

**Regarding Claims 6 and 20**, the system and method of claims 5 and 19, wherein the alert includes a list of one or more products included within the shopping list that were not purchased by the user (see at least column 2 lines 29-34 and column 10 line 61 to column 11 line 5).

**Regarding Claims 7 and 21**, the system and method of claim 1 and 15, wherein the one or more information packets distributed and received are tailored to the needs of the user according to profile information relevant to the user (Please note: Examiner interprets elements such as previously purchased items, budget constraints, and items currently desired as "needs of the user" and "profile information." See at least column 2 lines 29-46, Fig. 12 and the description thereof at column 15 line 24 to column 16 line 5, and column 1 line 67 to column 2 line 28.).

**Regarding Claims 8 and 22**, the system and method of claims 1 and 15 further configured to distribute and receive a refined shopping list from the computing system to the hand-held computer in advance of the shopping event (see at least the abstract, and column 1 line 67 to column 2 line 22. Please note: Examiner's interpretation of

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downloading a new list including prices of items and coupons on said items is a refined shopping list.)

**Regarding Claims 11 and 25**, the system of claim 1, wherein the user manually enters the shopping list information into the hand-held computer and the method of claim 15 wherein generating the shopping list on the hand-held computer comprises manually entering the shopping list into the hand-held computer (see at least column 7 lines 30-34).

**Regarding Claims 12 and 26**, the system of claim 1 wherein the user enters the shopping list information into the hand-held computer using an optical scanner and the method of claim 15 wherein generating the shopping list on the hand-held computer comprises entering the shopping list into the hand-held computer using an optical scanner (see at least column 4 line 15 through column 5 line 1. Please note Examiner's interpretation: "Light pen" as used in Ruppert is an optical scanner).

**Regarding Claims 13 and 27**, the system and method of claims 1 and 15 wherein the information packets distributed by and received from the computing system originate from one or more retail computing systems (see at least the abstract, column 2 lines 43-54, column 6 lines 27-38, column 19 line 67 to column 20 line 62, and as further described above with regard to claims 1 and 15, where information is transferred in both directions between retail computing systems and the hand-held computer).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert (US Patent No. 5,424,524) in view of Nambudiri (US Patent No. 6,640,214).**

**Regarding Claims 9 and 23**, Ruppert teaches the system and method of claims 8 and 22 as noted above under the section 102(b) rejections, and teaches a) the use of a hand-held computer for storing and displaying shopping lists, b) exchange of item information with store computers, and c) use of the displayed shopping list and exchanged information stored in the hand-held computer while shopping. Ruppert also discusses the use of written lists (see at least column 1 lines 25-37). Ruppert however does not disclose the refined shopping list being printed in advance of the shopping event. Nambudiri teaches the refined shopping list being printed in advance of the shopping event (see at least column 9 lines 4-11 and column 12 line 61 to column 13 line 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Ruppert to print out the refined shopping list in advance of the shopping event as taught by Nambudiri, in order to facilitate a more convenient shopping experience for the consumer and thereby encourage commerce by way of more shopping.

**10. Claims 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert (US Patent No. 5,424,524) in view of Tracy (US Patent No. 5,979,757).**

Regarding Claims 10 and 24, Ruppert teaches the system and method of claims 8 and 22 as noted above under the section 102(b) rejections, and teaches a) the use of a hand-held computer for storing and displaying shopping lists, b) exchange of item information with store computers, c) the modified shopping list with the exchanged information stored in the hand-held computer, and d) storing previous shopping lists including lists of previously purchased items. Ruppert does not disclose the refined shopping list including products the user has previously purchased from the one or more retail locations. Tracy teaches the inclusion of products the user has previously purchased from the one or more retail locations (see at least column 14 lines 9-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Ruppert to include products the user has previously purchased from the one or more retail locations as taught by Tracy, in order to provide clearly relevant information to the consumer at exactly the moment they are most likely to act on the information, thereby facilitating increased purchases.

**11. Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert (US Patent No. 5,424,524) in view of Tracy (US Patent No. 5,979,757).**

Regarding Claims 14 and 28, Ruppert teaches the system and method of claims 1 and 15 as noted above under the section 102(b) rejections, and teaches a)

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the use of a hand-held computer for storing and displaying shopping lists, b) exchange of item information with store computers, and c) the modified shopping list with the exchanged information stored in the hand-held computer. Ruppert also discusses the benefits of comparing information from several sources, and searching for coupons (see at least column 1 lines 15-43). Ruppert does not disclose the information packets distributed and received from the computing system originating from one or more supplier computing systems. Tracy teaches the information originating from one or more supplier computer systems (see at least column 10 lines 9-30. Please note Examiner's interpretation: "supplier" means a merchant that is potentially further removed from the ultimate consumer than the retailer, and who may provide product to the retailer for resale. Without this interpretation this claim would not further limit claims 1 and 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Ruppert to include information originating from one or more supplier computing systems as taught by Tracy, in order to facilitate commerce by increasing the amount of information available to the consumer during the crucial decision making period before and during the shopping event.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ogasawara, US Patent No. 6,123,259, September 26, 2000. Teaches an electronic shopping system including but not limited to mobile terminals, shopping lists, shopping histories, and recommendations;
- Jelen, US Patent No. 6,129,276, October 10, 2000. Teaches shopping cart mounted portable data device with direct user input, scanner, shopping list database from previous purchases, communication with retailer via wide area network, and other features;
- Becker, US Patent No. 6,168,079, January 2, 2001. Teaches a customer information terminal with docking member for data collection device communicating with host computer system and storing customer shopping data;
- O'Hagan, US Patent No. 6,314,406, November 6, 2001. Teaches customer information network including data storage device and portable transaction computer.
- Scroggie, US Patent No. 6,185,541, February 6, 2001. Teaches a system and method for delivering purchasing incentives and a variety of other retail shopping aids including targeted shopping lists through a computer network.
- Johnsen, US Patent No. 5,250,789, October 5, 1993. Teaches system including various means for displaying and manipulating shopping lists.
- Gershman, US Patent No. 6,401,085, June 4, 2002. Teaches wireless web based information retrieval, computing, and display system and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 703.305.0836. The examiner can normally be reached on M-F, 8:30-5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 703.308.1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine  
Patent Examiner  
March 18, 2005



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